

REMARKS

This paper is filed in response to the Restriction Requirement set forth in the Office action (Paper No. 20080119) mailed on 24 January 2008, reconsideration and re-examination are respectfully requested.

Listing of the Claims

Pursuant to 37 CFR §1.121(c), this listing of the claims, including the text of the claims, will serve to replace all prior versions of the claims, in the application.

Amendment of the Claims

Claims 1 through 3, 6 and 13 are amended by this Paper.

Status of the Claims

Claims 1 through 39 are pending in the above-captioned application.

Requirement for Restriction - 37 CFR §1.142

In the Office action mailed on 24 January 2008 (Paper No. 20080119), the Examiner required a restriction under 35 U.S.C. §121 and 37 CFR §1.142, between:

- **Group I:** Claims 1-12 and 14-39, drawn to a complex wireless service apparatus for trying the incoming using the public phone number of the complex wireless terminal is located in the premises with reference to the home location register and trying the incoming using the mobile communication phone number when the complex wireless terminal is located in a mobile communication service area, classified in class 455, subclass 445;
- **Group II:** Claims 13, drawn to a complex wireless service apparatus for performing Voice Over Internet Protocol service, classified in class 370, subclass 395.52.

Applicant's Response to Requirement for Restriction - 37 CFR §1.142

Applicants respectfully traverse the election requirement imposed in the Office action; but provisionally elect Group I. The Examiner has confirmed that claims 1 through 12 and 14 through 39 are directed to the elected subject matter of **Group I**.

Applicant's Traversal of the Requirement for Restriction - 37 CFR §1.142

Applicant objects to and traverses the restriction requirement on the grounds that the subject matter of the two groups overlap. In addition, the mandatory fields of search for the two embodiments are coextensive. Finally, it appears that the restriction requirement is being imposed merely for administrative convenience, and such a basis for imposition of a restriction requirement has been prohibited in previous decisions of the Commissioner.

Firstly, the Examiner has failed to show any type of burden, much less a serious burden, in the absence of a restriction requirement. In particular, not only has the Examiner failed to show that the search would impose a burden, but also the Examiner has failed to show that any burden would rise to the level of a serious burden. As stipulated in MPEP §803, if the search can be made without serious burden, the Examiner must examine the application on the merits, even if there are separate and distinct inventions. The Examiner has not alleged any serious burden in the Office action mailed on 24 January 2008 (Paper No. 20080119) and thus the Examiner must examine the entire application. Moreover, because no burden was shown, if the restriction is not withdrawn in the next Office action, the restriction requirement cannot be made final according to MPEP §706.07.

Secondly, whereas the Examiner has stated that the invention of Group I including claims 1-12 and 14-39, drawn to a complex wireless service apparatus, classified in class 455, subclass 445; and Group II including claims 13, drawn to a complex wireless service apparatus for performing Voice Over Internet Protocol service, classified in class 370, subclass 395.52, it is submitted that, in order to perform a comprehensive search, the Examiner is going to be compelled to perform some

searching in both classes 455 and 370. It is submitted that Applicant's foregoing listing of a search of the U.S. Patent Collection produced the above-repeated partial list of recent U.S. Patent publications and U.S. patent issued which are in fact classified in both class 445 and 370, subclass 370 and 395.52. A search of the U.S. Patent Collection produced the following partial list of recent U.S. Patent issues which are in fact classified in both class 455 and class 370, subclass 445, 395.52:

Results of Search in US Patent Collection db for:

(CCL/455/445\$ AND CCL/370/395.52\$): 6 patents.

	<u>PAT. №.</u>	<u>Title</u>
1	7,292,560	Wireless broadband service
2	7,139,577	Method for call control of communication terminal equipment wirelessly connected to communication networks
3	7,127,240	Method for selective mid-call call forwarding from mobile station
4	7,050,809	System and method for providing concurrent data transmissions in a wireless communication network
5	7,042,846	Restrictive costs in network systems
6	6,778,517	Wireless broadband service

The foregoing listing of art included within both Groups I and Group II demonstrates both the lack of burden upon the Examining staff in making a simultaneous search of both Groups I and II and the absence of evidence that Groups I and II are distinct. As specifically stated in MPEP §803, in imposing a restriction requirement, the Examiner must show that:

- (A) the inventions are independent (*see* MPEP §802.01, §806.04, §808.01) or distinct as claimed (*see* MPEP §806.05 - §806.05(i)); **and**
- (B) there will be a **serious burden** on the Examiner if the restriction requirement is not

imposed (*see* MPEP §803.02, §806.04(a) -§806.04(i), §808.01(a), and §808.02). It is respectfully submitted that there would not be a serious burden upon the Examiner in searching Groups I and II.

Thus, under long standing Office practice extending over approximately three decades, the fields of search are coextensive with respect to the two groups of claims, and therefore the restriction requirement serves no purpose other than to impose an undue burden and unnecessary expense upon the Applicants (*see* MPEP §802.01, §806.04, §808.01).

Thirdly, *MPEP* §806.03 states that:

“Where the claims of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, restriction therebetween should never be required. This is because the claims are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition” (emphasis supplied).

Why, then has this prohibition been violated in the above-captioned application where the basis for the Examiner’s averment that the subject matter of Group I and II are related as “subcombinations usable together in a single combination” when the “voice over Internet protocol” feature identified us a single embodiment has been disclosed? That fact that Applicant’s claims are very broad in scope, and cover a plethora of implementations of the principles of Applicant’s inventions, is not a basis for violating this prohibition against restriction. Withdrawal of this requirement is therefore respectfully urged.

For the above reasons, it is respectfully submitted that the restriction requirement is unnecessary, is not in accordance with the Rules of Practice or the *Manual of Patent Examining Procedure*, and constitutes the imposition of an undue burden and unfair expense upon the Applicants. Therefore, the restriction requirement should be withdrawn.

Conclusion

If the requirement for restriction is not withdrawn, then the Applicants reserve the right to file a Petition to the Commissioner because there is no *serious* burden upon the Examiner in searching the invention of Group I and Group II.

In view of the foregoing demonstration of the impropriety of this requirement, it is requested that the restriction requirement be withdrawn. It is further submitted that the application is in condition for examination on the merits, and early allowance is requested.

No fee is incurred by this response.

Respectfully submitted,



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